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1 RECORD OF ORAL HEARING

2
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES

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10 *Ex parte* JULIE A. SCHWARTZ, JAMES H. SCHWARTZ, JEANE S.
11 CHEN, HARRY E. GRUBER and EPHRAIM FEIG

12
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14 Appeal 2009-003994
15 Application 09/764,787
16 Technology Center 3600

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19 Oral Hearing Held: October 22, 2009

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23 Before HUBERT LORIN, LINDA E. HORNER and ANTON W.
24 FETTING, *Administrative Patent Judges*.

25
26 ON BEHALF OF THE APPELLANT:

27
28 PHILLIP ARTICOLA, ESQUIRE
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33
34 The above-entitled matter came on for hearing on Thursday, October 22,
35 2009, commencing at 9:38 a.m., at The U.S. Patent and Trademark Office,
36 600 Dulany Street, Alexandria, Virginia, before Deborah Rinaldo, Notary
37 Public.

PROCEEDINGS

JUDGE LORIN: Good morning, counsel. Would you first state your name and spell it, please.

MR. ARTICOLA: Sure. It's Phillip, two Ls, Articola, A-R-T-I-C-O-L-A.

JUDGE LORIN: Thank you. This is appeal number 2009-3994. We have read the record, we're familiar with it and you have 20 minutes. You may proceed.

MR. ARTICOLA: This case deals with efficient fundraising campaign over a wide area network such as the Internet. And to that end, I'll just go through the claims and sort of --

JUDGE FETTING: Could you speak up a little bit? I'm having trouble hearing.

MR. ARTICOLA: Sure. And to that end on claims, what you do is you have a Web site for a fundraising campaign. Let's say Salvation Army. And on that site, let's say me, Phil, can then sign up as a solicitor. I like the Salvation Army, so I will try to solicit donations from my colleagues and my friends. So by doing that, I have now signed up as a solicitor.

And then I have what's created as a personal donation page. Okay. I'm the solicitor. I'm Phil. I'm not the Salvation Army. And so I have this personal donation page that says my name is Phil, I work for company A and my campaign goal to solicit money for Salvation Army is \$800.

Once that's done, Phil, the solicitor, me, sends out e-mails to all of my colleagues and friends and neighbors, and in the e-mail that provides a link to my page, the solicitor, Phil. And so if you are one of my friends or colleagues,

1 you see my e-mail, you open it up and say, okay, here is this e-mail from Phil
2 asking for money for Salvation Army.

3 You click on a link and go to my page. Not the Salvation Army. My
4 page, Phil Articola's personal donation page. And there you see Phil is asking
5 for money for Salvation Army, he has a goal of \$800, he's got a team of Fred
6 and Jane. I know Fred and Jane, and they are all working together to get
7 enough money to meet their goal.

8 Okay. So I, the donor, not Phil, not Salvation Army, the donor says,
9 You know what, I'll donate, and then donates via the personal donation page.
10 And then when that's done, that money will be added to the solicitor's goal. It
11 increases by how much money the donor donates and there's a plaque in other
12 claim elements where the donor's name may appear as one of the persons who
13 donated on behalf of Phil, the solicitor.

14 Okay. So that's basically the invention in more -- but the claims recite
15 that stuff. So in the -- the invention describes -- the specification describes
16 that having that connectivity between the solicitor and a donor makes it more
17 likely that the donor will donate because the person knows the solicitor and is
18 sort of being -- it's not as harsh or as cold as just go right to a donation page of
19 the Salvation Army and say, Gee, do I really want to donate or not?

20 In the rejections, the primary reference is Costin, which is fairly relevant
21 in that it's using the Internet to solicit donations from companies. The
22 difference being that in Costin you get an e-mail, you get an e-mail from, say,
23 me, Phil, and says if you want to donate, go to the Salvation Army's donation
24 page. Then you say, Maybe I will, maybe I won't.

25 If you do, you go to that donation page of the Salvation Army. You
26 don't go to

1 any donation page of a solicitor. That doesn't exist. And then you make that
2 payment via the Salvation Army's page. So there's a little more of a sort of
3 coldness there. The difference being ours we have this third party, the
4 solicitor, where it -- that's the place where you are going to go.

5 JUDGE FETTING: Excuse me. You said you would go to the
6 Salvation Army Web page but in paragraph 19 of Costin, it suggests that you
7 could also go to the sponsor's. So in other words --

8 MR. ARTICOLA: But not to make a payment. To go there and say,
9 Oh, this is the sponsor's page. But that's not where you make the payment. I
10 can go there and see, oh, here is the sponsor. There's no teaching or
11 suggestion that that's where you are going to make a payment on. That's my
12 understanding.

13 Now, the Examiner, I think, sees the same thing and applies McBrearty
14 to make up for that missing feature in Costin. And McBrearty deals with
15 telemarketing and ways to increase donations via telemarketing. McBrearty
16 was a 1986 article. At that time the Internet was just getting some headway.
17 But McBrearty doesn't deal with Internet. Maybe it's too early. It deals with
18 basically getting to know the person you are calling, finding some
19 commonality, some, you know -- something that you both have of interest.
20 So it's sort of common sense stuff, that you would call a person and say -- find
21 out a little about them. Maybe you have interests in common being you both
22 like cricket and you are both from England and you talk about that and finally
23 after a while you get a little warm and fuzzy and get to know them and
24 eventually that might increase your chances of getting a donation from that
25 person.

26 Okay. I must say, looking at it from an objective standpoint, looking at

1 McBrearty and having hindsight reconstruction of the invention, looking at the
2 present invention, I just don't see how -- how it does teach the features missing
3 in Costin. It's dealing with telemarketing, it's dealing with getting to know
4 someone but no -- there's no features that are missing in Costin that are made
5 up by McBrearty. It's different. It's telemarketers. It's not Internet.

6 And second, leaders know teaching or suggestion of going to a personal --

7 JUDGE FETTING: As you said, it deals with telemarketing, but to one
8 of ordinary skill, it explicitly says that personalization is the key.

9 MR. ARTICOLA: Yeah. So personalization being getting to know the
10 person to get donations. The donations are still for Salvation Army. I'm not
11 saying now that we have this rapport, go to my e-mail address or -- maybe you
12 say Internet doesn't exist back then. I don't know. It did exist, but go to --
13 here is my address, send your check to me and then I'll forward it to Salvation
14 Army.

15 JUDGE FETTING: But one reading Costin wouldn't one say, okay,
16 personalization is the key, then I would personalize the Web page?

17 MR. ARTICOLA: Well, but Costin personalizes to the extent that says
18 go to the Salvation Army's page.

19 JUDGE FETTING: Or go to the sponsor's Web page.

20 MR. ARTICOLA: Right, but it doesn't say anything about make the
21 payment via the sponsor's Web page because that's really what ours invents.

22 JUDGE FETTING: It says go to the site. And the site, early in the
23 paragraph, was the sponsor's Web page.

24 MR. ARTICOLA: Sponsor, you mean like the Salvation Army?

1 JUDGE FETTING: No, no. Like U.S. Steel might take on the
2 Salvation Army, they might sponsor. So you go to a U.S. Steel page for --
3 on behalf of
4 the --

5 MR. ARTICOLA: Exactly. But then you go there and you are still not
6 going to make the donation at the U.S. Steel's page. You are going to make it
7 via the Salvation Army's page.

8 JUDGE FETTING: Well, U.S. Steel's page.

9 MR. ARTICOLA: What you are saying is really looking back and
10 saying I have read the present invention, I understand the way of linking it to
11 the user to the solicitor, to U.S. Steel in your case, and to get that team value
12 increased for the U.S. Steel team, nothing like that exists in Costin or in
13 McBrearty.

14 They are not trying to set up these teams and plaques but also set up a
15 way that I know -- I feel better about U.S. Steel than I do about Salvation
16 Army, so I want to make that donation via U.S. Steel's page.

17 That's what our invention is about. In Costin, yeah, you can go to U.S.
18 Steel and find out about them; and even with McBrearty saying learn more
19 about U.S. Steel, there's still that missing element of go to U.S. Steel, make the
20 donation via U.S. Steel so U.S. Steel gets the credit, in effect.

21 JUDGE FETTING: I'm looking at paragraph 19 in Costin. It says,
22 Connect to the site, make a donation and get a receipt in a few minutes.
23 And the site is that of the business sponsor or cause which sets up a campaign
24 page. So the business sponsor would be U.S. Steel. And later on, on -- it says
25 that you make a donation on that site. So on the sponsor's site.

1 MR. ARTICOLA: Yeah, but if I read paragraph 10, I read it as there's a
2 campaign page and then there's a Web site and it appears, if I read paragraph
3 10 correctly --

4 JUDGE FETTING: I'm looking at paragraph 19.

5 MR. ARTICOLA: Yeah, 19, which is a portion of that -- I mean, is a different
6 area.

7 JUDGE FETTING: But see, paragraph 19 then says the system
8 perpetuates itself in a viral manner by having the primary -- the solicited
9 becomes a primary and starts the process over again.
10 So 19 would certainly suggest that the person who has been solicited would
11 then create their own Web page and start the process all over again.

12 MR. ARTICOLA: But then doesn't that person now become the --

13 JUDGE FETTING: The sponsor. The person is now the sponsor.

14 MR. ARTICOLA: Or are they the person who is actually getting the
15 money? They are the ones who actually are using the money. They are the
16 Salvation Army, so to speak.

17 JUDGE FETTING: No, no, no. Someone who has been solicited then
18 becomes -- and has become a donor then becomes a primary donor themselves
19 and starts the process over again. So this is the person who has been solicited
20 now becomes a sponsor and starts the process over again.

21 MR. ARTICOLA: I see what you are saying in terms of the person
22 being solicited now becomes a secondary sponsor, but I read that as saying that
23 that person still has to go to the Salvation Army's site to make the donation.
24 Yeah, you can go to the secondary sponsor's site and find out about the
25 secondary sponsor, but when it says "make a donation," I see that to be read

1 with respect to paragraph 10 which says explicitly that you go to the campaign
2 page's Web site to make the donation.

3 And paragraph 19 kind of leaves out the things that I think paragraph 10
4 puts more detail into which is you go to the campaign page and make the
5 donation.

6 Yeah, you can go to the first solicitor and the second solicitor and the
7 third solicitor and find out about U.S. Steel and Alcoa and all the companies
8 that are friends or people who are trying to collect for the Salvation Army, but
9 when you make the donation, at least the way I read that paragraph 19 in view
10 of paragraph 10 of Costin, you still have to go to that original Web site of
11 Salvation Army to do that actual payment and not through some nice pages of
12 a solicitor that you have gone through and found out about U.S. Steel and
13 Alcoa.

14 So I think when it says "make a donation," I think that still means make
15 a donation in accordance with paragraph 10, which is you go to the site of the
16 Salvation Army and then make a donation at that site. That's how I interpret
17 that because it leaves a little bit out and I think paragraph 10 puts that meat
18 into it that's missing in paragraph 19.

19 JUDGE LORIN: Counsel, I'm having a little bit of a problem following
20 the argument. You have a claim here hosting a Web site and then providing a
21 link to personal donation page. Is your argument that the prior art doesn't
22 show a personal donation page?

23 MR. ARTICOLA: No. It's that the prior art doesn't show -- well, yeah,
24 it doesn't show a personal donation page that has a mechanism to make the
25 payment right there. What it shows is there's a personal page of the solicitor.

1 It's not a personal donation page because it doesn't -- you can't make the
2 payment on that page.

3 It says I, as we were discussing with Judge Fetting -- you go to U.S.
4 Steel, which is a sponsor of Salvation Army to try to collect money, you go to
5 U.S. Steel's page and find out U.S. Steel is trying to collect money for
6 Salvation Army, but it's not a personal donation page because you have to
7 make the payment in Costin via Salvation Army's page.

8 So it's basically a solicitor's page. It's a personal page of a solicitor but
9 not a personal donation page. The word donation means that that's the page
10 where you actually make the payment, put your credit card information and get
11 charged.

12 JUDGE LORIN: So if I understand you correctly, your argument is that
13 the personal donation page is a particular type of page that the prior art doesn't
14 show?

15 MR. ARTICOLA: Right. And also the campaign goal, we want \$800
16 to collect. So campaign goals go hand in hand. There's this campaign goal
17 that the solicitor wants to collect up to \$800 for this physical year to support
18 the Salvation Army.

19 And also the way to make a payment on that page and not have to go to
20 the Salvation Army's page to make that payment. So the step in 58 which is
21 the third step, you receive a charitable contribution via the personal donation
22 page from a donor. So the donor makes the payment via that page and not
23 through the Salvation Army's page.

24 JUDGE HORNER: So if the person reached the Salvation Army's page
25 via a personal donation page and then made the contribution on the Salvation

1 Army's page, that's not receiving a charitable contribution via the personal
2 donation page?

3 MR. ARTICOLA: No, it's not. So if you said, I just want to go directly
4 to the Salvation Army site, make the payment right there, you can do that but
5 you are making the payment not in accordance with that step. You are making
6 it in accordance with -- you are paying it through the Salvation Army's page
7 and not through the personal donation page.

8 JUDGE FETTING: So what's the difference between a personal
9 donation page and the Salvation Army's donation page?

10 MR. ARTICOLA: The big difference is that as a donor, you know the
11 person who sent you that e-mail. There's a warm fuzzy feeling --

12 JUDGE FETTING: There's no patentable distinction on warm and
13 fuzzy. From a patentable standpoint, what's the distinction?

14 MR. ARTICOLA: Well, the distinction is it has information of me,
15 Phil, the solicitor.

16 JUDGE FETTING: So the difference is the informational content on
17 the page?

18 MR. ARTICOLA: And also the fact that you can make a payment on it.

19 JUDGE FETTING: I asked what's the difference between a donation
20 page and a personal donation page? Both of them you can make a donation
21 on. Clearly Costin has a page that you can make a donation on. I don't think
22 that's under dispute. So is the distinction merely one of the contents of that
23 page?

24 MR. ARTICOLA: That and the fact that you can make -- well, the fact
25 you can make a payment.

26 JUDGE FETTING: You can make a payment in either case.

1 MR. ARTICOLA: Well, in Costin you can make it only by the
2 Salvation Army's page.

3 JUDGE FETTING: So the difference is the content?

4 MR. ARTICOLA: But also the fact that you can make a payment. In Costin
5 you can't do step 4 because you are making a payment not via a personal
6 donation page.

7 JUDGE FETTING: You are making a payment via a donation page.

8 MR. ARTICOLA: It's a Web site.

9 JUDGE FETTING: But via a donation page.

10 MR. ARTICOLA: But not of a solicitor.

11 JUDGE FETTING: Not what you are saying is a personal. So that gets
12 back to the question, what's the difference between a personal donation page
13 and a donation page? It sounds like content is the only difference.

14 MR. ARTICOLA: There's content difference but there's also the fact in
15 the method claim, which is 58, the ability to make an actual payment.

16 JUDGE FETTING: But you can make a payment on a donation page.

17 MR. ARTICOLA: On a donation page. But in our case it's a donation
18 page of a solicitor.

19 JUDGE FETTING: So again, the difference is the content.

20 MR. ARTICOLA: But in the systems claims -- I guess you could say
21 it's more explicit in the systems claim. In the method, though, I think in terms
22 of step 4, it's something that can't occur if you read those features in
23 accordance with the specification.

24 JUDGE LORIN: How would I know that I'm going to your personal
25 page to make a donation?

1 MR. ARTICOLA: Well, because you got my e-mail. My e-mail
2 saying, Hey, I want you to donate money. The link takes you to me, the
3 solicitor's page, where it says, I'm Phil, I'm collecting money for Salvation
4 Army, my campaign goal is \$800, please donate.
5 You click on that little thing, you donate via me, Phil, the solicitor.

6 JUDGE LORIN: So if I understand you, you are covering sending an
7 e-mail with a hyperlink in the e-mail, clicking on the hyperlink that sent you to
8 a web page and on that web page you can make a donation.

9 MR. ARTICOLA: The web page is not the Salvation Army's Web page.

10 JUDGE LORIN: I understand that.

11 MR. ARTICOLA: But the Web page also has information about me.

12 JUDGE LORIN: Well, I'm sure there's more information.

13 MR. ARTICOLA: It also has some goals and there's a plaque and
14 there's other features where the plaque is updated because you are part of a
15 team now. And there's other features I haven't really discussed much.
16 So you are trying to look at as I'm not just donating but I'm also part of a team
17 that's reaching a goal. We're ahead of team A, B and C. We're team D and
18 you see that part. You see how you are faring with the other people from
19 your -- maybe your competitor companies and so maybe gives you a little bit
20 of extra incentive, I guess, to donate.

21 So a lot of these other features are involved sort of secondarily. In that
22 regard, there's also some stuff in the spec -- I'm sorry, in the Appeal Brief with
23 secondary considerations about the increased donations from Salvation Army,
24 AIDS Walk, Epilepsy donation Web sites that they show to increase the
25 amounts of donations via this --

1 JUDGE HORNER: So what does that secondary consideration continue
2 to show, that the system works?

3 MR. ARTICOLA: Well, it works well. It's getting people to donate via
4 this friend-to-friend via solicitor page, that people are actually more inclined to
5 donate when it's -- they don't go right to the Salvation Army's page. They see
6 it's Judge Horner's page who is asking me for money and I would rather give
7 money through Judge Horner's page because I like Judge Horner and --

8 JUDGE HORNER: But in terms of secondary considerations, if you
9 could put it in a basket, would it be commercial success, unexpected results?
10 What are you trying to --

11 MR. ARTICOLA: Commercial success. And there is a 112 rejection.
12 Is that even worth discussing? It seemed like the features there were pretty
13 much in the application or, at worst, in the 761 is disclosure which is
14 incorporated by reference where the donor can have an ability to --

15 JUDGE FETTING: I'm sorry. Where is the 112 rejection?

16 MR. ARTICOLA: The 112 rejection was -- there's a step that says,
17 Updating according to instructions from the donor, one or more virtual plaques
18 displayed on the one or more Web pages to recognize new donors.

19 JUDGE FETTING: I saw an objection. I had trouble finding the
20 rejection. Can you show me where the rejection was?

21 MR. ARTICOLA: I thought there was -- I'll just do a quick check here.
22 Yeah, there was a new matter --

23 JUDGE FETTING: That's an objection, right?

24 MR. ARTICOLA: Yeah.

25 JUDGE FETTING: So there's no rejection.

26 MR. ARTICOLA: I'm sorry.

1 JUDGE FETTING: Yeah, that's not before us, so you don't need to
2 discuss that.

3 MR. ARTICOLA: Okay. Good point. So, yeah, basically that's the
4 invention which is hopefully to allow people to go ahead and give money
5 based on a little bit of a friend-to-friend type of way. And it has worked,
6 seems like it's -- companies that have used it have gotten success and we think
7 that those features are not shown in the prior art.

8 JUDGE FETTING: I have just one question. From the copy of claims I
9 have, it looks like both claims 75 and 97 depend from 73 and 95.

10 MR. ARTICOLA: Yeah, I saw that.

11 JUDGE FETTING: So it looks as though they are --

12 MR. ARTICOLA: They are cancelled claims.

13 JUDGE FETTING: So I'm reading it right?

14 MR. ARTICOLA: You are reading it right. That depends on the
15 independent claim. It wasn't corrected in the last response. So you are
16 absolutely correct and they are depending on cancelled claims, which is not
17 good.

18 JUDGE LORIN: Thank you, counsel.

19 MR. ARTICOLA: Thank you for your time.

20 (Whereupon, the proceedings at 10:02 a.m. were concluded.)